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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,974	01/16/2004	Robert J. Del Principe	9437.17504-CIP	6204

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EXAMINER	
WONG, STEVEN B	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,974	DEL PRINCIPE, ROBERT J.	
	Examiner	Art Unit	
	Steven Wong	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *7-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. 11/7/05
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Claims 7-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species/invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 1, 2005.

Response to Amendment

2. The supplemental reply filed on October 26, 2005 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The election filed October 26, 2005 is a supplemental response to the election filed September 1, 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative under 35 U.S.C. 103(a) as being obvious over Folden (5,221,267). Regarding claim 1, Folden discloses an arrangement comprising a first section (28) and a second section (30) and an insert (32) adapted to couple the first and second sections. The insert has an annular score

line (38). Further, note column 6, lines 51-54 stating that the tubing is made from polycarbonate or other materials. The polycarbonate is seen as a polymeric material that inherently possesses an elastic memory to allow the shaft to return to a straightened position if a maximum bending angle is not exceeded.

In the alternative, it would have been obvious to one of ordinary skill in the art to form the tubing from a material that is more elastic in order to provide a more flexible tubing that does not fracture as easily.

The tubing of Folden is inherently capable of functioning as a novelty sports apparatus. Further, the limitation appears in the preamble of the claim. The recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 3, the first and second sections present female fittings to which a male fitting of the tubing coupling is inserted.

Claim Rejections - 35 USC § 103

6. Claims 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Folden. Regarding claim 2, it would have been obvious to one of ordinary skill in the art to form the tubing coupling from PVC in order to take advantage of that material's well known physical characteristics.

Regarding claim 4, it would have been obvious to one of ordinary skill in the art to form the tubing coupling with a female fitting and the tubing sections with a male fitting as such represents a mere reversal of parts and their associated functions.

Regarding claim 5, it would have been obvious to form the tubing coupling from a material that requires a 45 degree maximum bend angle for achieving fracturing of the coupling in order to provide a more flexible tubing that does not fracture easily.

7. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai (5,042,805) in view of Fenton et al. (5,093,162). Regarding claims 1 and 6, Nakai discloses a novelty sports apparatus comprising a first section (7), a second section (9) and an insert (9) coupling the first and second sections to form a shaft. Note Figure 2(b) showing an annular score line (10) in the insert.

Fenton discloses a golf club shaft formed from a polymeric material. It would have been obvious to one of ordinary skill in the art to form the shaft of Nakai from a polymeric material in order to take advantage of that material's well known physical characteristics.

Regarding claim 2, note column 7, lines 14-25 stating that vinyl resins formed by the polymerization of vinyl chloride may be used.

Regarding claim 3, note Figure 2(a) showing the shaft (8) being inserted into the handle (7).

Regarding claim 5, the polymeric material of Fenton would obviously possess a substantial maximum bend angle in order to withstand the forces during a golf swing. It would have been obvious to one of ordinary skill in the art to provide the shaft with a maximum bend angle of 45 degrees in order to create a strong shaft that is unlikely to fracture during a golf

swing. Further, the particular angle of 45 degrees is considered to be obvious lacking a showing of criticality for the claimed angle by a new and unexpected result obtained therefrom

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai (5,042,805) in view of Fenton et al. (5,093,162) and Murphy (4,253,666). Murphy discloses that it is well known in the art of golf clubs to provide a head that is inserted into a female fitting of the shaft. It would have been obvious to one of ordinary skill in the art to provide the golf club of Nakai with a female fitting for the shaft and a male fitting for the club head in order to securely attach the shaft and head together.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,935,964 in view of Pond, III. Patent '964 discloses a novelty golf club shaft comprising a polymeric material (that can be PVC)

having an annular score line about which the shaft is weakened to allow its fracture when the shaft is bent beyond its maximum bend angle. However, Patent '964 lacks the teaching for the weakened section to be formed as an insert.

Pond, III reveals that a novelty golf club wherein first and second sections of a golf club are connected by an insert. The golf club is bent beyond a maximum bend angle wherein the insert is broken. It would have been obvious to one of ordinary skill in the art to provide the golf club of Patent '964 with an insert comprising the weakened section in order to allow the golf club to be used repeatedly with only the insert being replaced.

Regarding claims 4 and 5, Pond, III is seen as teaching a male fitting for the insert which is received by a female fitting in the shaft. It would have been obvious to one of ordinary skill in the art to provide the golf club of Patent '964 as modified by Pond, III with a female fitting for the insert and a male fitting for the shaft section in order to provide an alternative structure that also firmly attaches the members together.

Regarding claim 6, note claim 2 of Patent '964.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Wong
Primary Examiner
Art Unit 3711

SBW
November 7, 2005